Remarks

Claims 1, 2, 7-11, 14, 15, 17 and 19 are presently pending. A Supplemental Preliminary Amendment filed on September 2, 2005 amended Claims 1, 11 and 19 and cancelled claims 3 and 4. The present Office Action, however, does not acknowledge entry of that amendment and appears to have ignored the amendment in its claim analysis. In addition, Claims 1, 11, 17 and 19 are currently amended.

Claims 19 and 21-24 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Office Action's rejection is factually and legally deficient for several reasons. First, the Office Action misstates and mischaracterizes the limitations in question, effectively rewriting limitations of the claims. Second, the Office Action misinterprets its own rewritten limitations, twisting the claim scope so as to make the claim fit the Office Action's desired interpretation. Third, the Office Action, without evidence, makes blanket (and factually inaccurate) statements concerning "the generally accepted rules of poker and its variants." Fourth, and finally, the Office Action uses an improper legal standard for determining enablement.

First, the Office Action misstates and mischaracterizes the limitations in question, effectively rewriting limitations of the claims. The Office Action asserts at page 2 that Claim 19 "discloses a method that concludes the end of a poker game by checking if a game parameter is equal to a terminating value." Applicants respectfully submit that the Office Action's statement is not an accurate characterization of the claim. The text of the claim recites the limitation of "determining if [a] game parameter is equal to the terminating value; and if the game parameter is equal to the terminating value, terminating the session." Applicants respectfully note that the claim does not "disclose" these limitations as the Office Action states, but rather "recites" them. In addition, the claim does not recite a step of "conclud[ing] the end of a poker game," but rather "terminating the session" "if the game parameter is equal to the terminating value." Similarly, the Office Action states at page 2 that "dependent claims (21-24) further describe the terminating value as the rank or suit of a card, the outcome of a hand, or

based on at least one card." The claims as written specifically recite that the terminating value "corresponds" to one of "a rank of a card," "a suit of a card," "at least one card, or a predetermined hand outcome." Applicants respectfully submit that this rejection must be analyzed in light of the claim as written.

Second, the Office Action misinterprets its own rewritten limitations, twisting the claim scope so as to make the claim fit the Office Action's desired interpretation. The Office Action reads the term "tie" into the claims, and goes on to assert that ties are rare and/or impossible. Applicants again respectfully submit that the claims should be considered as-written; specifically, enablement should be determined based on whether the limitation of "determining if the game parameter value is equal to the terminating value" is enabled by the specification.

Third, the Office Action, without evidence, makes blanket (and completely inaccurate) statements concerning "the generally accepted rules of poker and its variants." Specifically, the Office Action makes three different factually incorrect statements regarding the "generally accepted rules of poker:"

(1) "the outcome of a game resulting in a tie is rare"

Nearly all variants of poker allow for ties, and in many variants of poker, ties are common. For example, in Texas Hold-em, a player combines two personal cards ("hole cards") with five community cards (the "board") to create the best-possible five card poker hand. Ties frequently occur when two players have the same high hole card and a low kicker. For example, if Player A holds As3d and Player B holds Ac4h, a board having five cards ranked five or higher and fewer than four cards to any given suit will result in a tie. Even if the board allows for a flush, a board containing five hearts ranked higher than 4 or five diamonds ranked higher than 3 will still result in a tie in this example.

Another example in which ties are even more common is the table game of Pai Gow Poker. In this variant of poker, a player is dealt seven cards and separates them into a five card "high" hand and a two card "low" hand. These hands are played against a dealer's own high and low hands. The chances of tie or "push," i.e., a player winning the high hand but losing the low hand and vice versa, can exceed 40%.

(2) "when [a tie] does occur, the player with a higher chip count is determined the winner"

This statement is simply wrong. Applicants are aware of no variant of poker in which a player with a higher chip count wins a tie. The size of a player's chip count considered only when determining whether to call or raise a bet. In table stakes games, for example, a player's chip count at the beginning of a hand only limits the amount that can be won or lost on that hand, but has no "tie-breaking" effect.

(3) "it is impossible under the rules of poker to end a game of video poker based on the player receiving an outcome equal to value [sic] determined by a program."

Apparently relying on its incorrect assumption that ties are "rare" and that a "higher chip count" breaks all ties, the Office Action concludes that a video poker game cannot be ended based on a player receiving an outcome equal to a value determined by a program. However, the Office Action concedes that ties are at least "rare," and thus, possible. Therefore, a player can receive an outcome equal to a value determined by a program. Applicants again also note that the claim is not directed solely to "ties" as the Office Action assumes, but to the limitation of "determining if the game parameter value is equal to the terminating value." This limitation may include, but are not limited to, ties, partial ties (e.g., a terminating value of "a pair of jacks" without regard for the remaining cards), or other non-tie situations (e.g., a terminating value of "two pair" without regard for rank, a terminating value of a "straight" or "flush"). Therefore, the Office Action's fallacious assertion that a game parameter being equal to a terminating value is impossible because ties are rare is facially improper.

Fourth, and finally, the Office Action uses an improper standard for determining enablement.

> In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first

> paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

MPEP 2164.04. Here, for example, Applicants' Specification describes multiple embodiments that include a "game parameter value that is associated with a video poker game" and which determine "if the game parameter value is equal to [a] terminating value." For example, ¶207-209 state that "[e]xamples of parameters include: . . . a number of video poker hands played during a session; . . . a number of Aces received by a player in video poker, and a number of losing handle pulls achieved by a player." Similarly, and again without being limiting, ¶ 254. states that"[e]xamples of terminating values that may be useful in video poker include, without limitation, a rank of a card (*e.g.*, "9," Ace), a card suit (*e.g.*, Hearts), a particular card (*e.g.*, Jack of hearts), a particular hand outcome (*e.g.*, a flush, three of a kind).

Applicants note that none of these examples necessarily relate to "ties," yet all of these examples are enabling embodiments of the claims as written. Therefore, even if all of the Office Action's factual assertions regarding the rules of poker were true (and they are not), the claims are still enabled by the specification. For at least the above reasons, Applicants respectfully request that the above rejection be withdrawn and the claims allowed.

Claims 1, 2, 5, 6, 10-16 and 19-24 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,733,389 to Webb et al. ("Webb" hereinafter). This rejection is respectfully traversed.

First, as noted above, this rejection appears to be based on the claims as originally filed, not on the claims as amended by the September 2, 2005 Supplemental Preliminary Amendment. Accordingly, the rejections fail to consider or address all of the limitations of any of claims 1, 2, 5, 6, 11-16 and 19-24. For this reason alone, the rejection of these claims fails.

Second, Applicants respectfully submit that Webb et al. is not prior art under section 102(b). Section 102(b) states that "[a] person shall be entitled to a patent unless . . . (b) the invention was patented or described in a printed publication in this or a foreign

country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." (emphasis added). Webb was patented on May 11, 2004, after the March 4, 2003, effective filing date of the present application (see Specification at ¶ 100), and even after the actual filing date of March 4, 2004. For this reason alone, the rejection of claims 1, 2, 5, 6, 10-16 and 19-24 should be withdrawn.

Applicant respectfully notes that claim 10 has not been amended. Thus, a rejection under any other subsection of section 102, even if based on the same reference, would constitute "a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in [a newly filed] information disclosure statement" and cannot be made final. MPEP 706.07(a).

Even if Webb were prior art under section 102(b), Webb still fails to disclose all the limitations of the claims for the reasons listed below.

Claim 1 recites a method comprising, *inter alia*, "initiating, at a gaming device operable to facilitate a wagering game, a game session of indeterminate duration, wherein the game session comprises a plurality of plays of a game and wherein the game session is not defined by either a predetermined number of handle pulls or a predetermined period of time; determining a game variable defining the game session; determining a terminating value associated with the game variable, the terminating value being based on a running count of a number of losing game outcomes during the session; determining a current value of the game variable; and terminating the game session based on the terminating value and the current value."

Webb does not disclose these features, particularly " initiating, at a gaming device operable to facilitate a wagering game, a game session of indeterminate duration, wherein the game session comprises a plurality of plays of a game," or "terminating the game session based on the terminating value and the current value." Webb is directed to receiving individual wagers for each individual game, with each single game having a single outcome. The Office Action relies on Col. 2:30-31 of Webb as disclosing a game parameter ("the marker") and on Col. 3:30-31 as disclosing a terminating value ("the termination trigger") with respect to a secondary bonus game, but this bonus game is based solely on the outcomes of the primary games, not on any session as defined by Applicants' claim.

Accordingly, Webb fails to disclose, teach or suggest "receiving a wager for a game session of indeterminate duration" or "terminating the game session based on the terminating value and the current value." That is, there is no teaching in Webb of receiving a single wager for a session that may have more than one game or gaming event. Claim 2 depends from claim 1 and is allowable for at least the same reasons.

Claim 10 recites a method comprising, *inter alia*, "determining at least one game parameter that is associated with a game; for each at least one game parameter, determining a respective terminating condition that is associated with the game parameter; initiating a flat rate play session of the game; determining if at least one terminating conditions is satisfied; and if at least one terminating conditions is satisfied, terminating the flat rate play session, in which the at least one game parameter corresponds to at least one of: a probability, a probability of a player entering a bonus round, and a rate of expiration of a predetermined game symbol."

Webb does not disclose these features, particularly initiating or terminating "a flat rate play session." Similar to the discussion of the term "session" and "game session" above, the plain meaning of flat rate play session is not consistent with the Office Action's interpretation. In addition, Applicants have explicitly defined the limitation "flat rate play session" at paragraph 123 of the specification:

> The term "flat rate play session" may refer to a game session that is associated with a flat rate price. For example, a player may be able to play a desired number of handle pulls for a set price. In another example, a player's flat rate play session is not defined by time or by handle pulls, and will not end until some terminating condition has occurred (*e.g.*, the player receives a flush in a video poker game).

Accordingly, Webb fails to disclose, teach or suggest initiating or terminating "a flat rate play session."

Claim 11 recites a method comprising, inter alia, "receiving a wager for a game session, the game session including a plurality of handle pulls, wherein the game session

is not defined by either a predetermined number of handle pulls or a predetermined period of time; initiating the game session; determining a game parameter that is associated with the game session, the game parameter being based on a number of bonus rounds achieved during the game session; determining a terminating value that is associated with the game parameter; determining a current value of the game parameter; and ending the game session based on the terminating value and the current value."

As discussed above in detail with respect to claim 1, Webb does not disclose these features, particularly "receiving a wager for a game session, the game session including a plurality of handle pulls, wherein the game session is not defined by either a predetermined number of handle pulls or a predetermined period of time."

The Office Action must give claims "their broadest reasonable interpretation consistent with the specification." MPEP 2111, quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). The Office Action appears to be improperly interpreting the limitation "game session" as comprising a single game having a single gaming event, e.g., a handle pull or reel spin. This is inconsistent with the usage of the term "session," both in the body of the claim, and as explicitly defined in the specification.

Applicants respectfully submit that the plain meaning of "game session" implicates a plurality of games, events, stages, etc. To the extent that the Office Action asserts that the broadest reasonable interpretation of the term includes a single game having a single wagering event, Applicants respectfully note that the term is explicitly defined in Applicants' specification at paragraph 122:

> The terms "session," "game session," "gaming session," and "play session" shall be synonymous and may refer to a series of plays, game stages, and / or games. Play during a gaming session may take place at one gaming device, at multiple gaming devices, and / or during a continuous period of time (*e.g.*, in a casino location). As with a game, a gaming session may end voluntarily or involuntarily. The end of a game session, as discussed herein, may be defined, for example, by a number of handle pulls, by a period of time, by the accomplishment of one or more objectives, by the occurrence of a trigger or event, by the satisfaction of one or more conditions, and / or by a game parameter becoming associated with a particular value (e.g., a terminating value). A session might be purchased by means of purchasing a contract from a casino, wherein the contract specifies terms such as, for example, a price to be paid by the

> purchaser for the contract, a duration of play of a gaming device, and a threshold of credits above which the player may collect winnings from a gaming device. Apparatus and methods which, among other things, permit and enable various ways of providing contract play and game sessions such as prepaid sessions, flat rate play sessions, and which are appropriate for use in accordance with the present invention are disclosed in pending U.S. Patent Application No. 10/001,089, filed November 2, 2001, entitled "GAME MACHINE FOR A FLAT RATE PLAY SESSION AND METHOD OF OPERATING SAME," the entirety of which is incorporated herein by reference for all purposes.

The broadest reasonable interpretation of the "session" limitation still includes a series of events, i.e., even an interpretation in which a session is a single game must still include a series of plays, pulls, stages etc. To the extent the Office Action has established any alternative "plain meaning" for this term, Applicants respectfully submit that "[w]here an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. MPEP 2110.01, quoting *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999). Accordingly, the Office Action is not permitted to redefine the term "game session" to be a single game having a single gaming event or outcome.

Claims 14 and 15 depend from claim 11 and are allowable for at least the same reasons as claim 11.

Claim 19 recites a method comprising, inter alia, "determining a game parameter value that is associated with a video poker game; determining a terminating value that is associated with the game parameter value, the terminating value corresponding to a predetermined video poker hand; receiving a wager for a session of the video poker game, the session including a plurality of hand outcomes, wherein the session is not defined by either a predetermined number of hand outcomes or a predetermined period of time; initiating the session; determining if the game parameter value is equal to the terminating value; and if the game parameter value is equal to the terminating value, terminating the session."

As discussed above in detail with respect to claim 1, Webb does not disclose these features, particularly "receiving a wager for a session of the video poker game, the

session including a plurality of hand outcomes, wherein the session is not defined by either a predetermined number of hand outcomes or a predetermined period of time."

Accordingly, for at least the above reasons, Applicants respectfully request that the above rejection of claims 1, 2, 10, 11, 14, 15, and 19 be withdrawn and the claims allowed.

Claims 7-9, 17 and 18 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,551,187 to Jaffe ("Jaffe" hereinafter). This rejection is respectfully traversed.

Claim 7 recites a method comprising, *inter alia*, "determining at least one game parameter that is associated with a game; for each at least one game parameter, determining a respective terminating condition that is associated with the game parameter; initiating a flat rate play session of the game, at a gaming device operable to facilitate a wagering game; determining if at least one terminating condition is satisfied; and if at least one terminating condition is satisfied, terminating the flat rate play session, in which the at least one game parameter corresponds to a predetermined configuration of a plurality of game elements corresponding to a predetermined game outcome."

Jaffe fails to disclose, teach or suggest these limitations, particularly initiating or terminating a "flat rate play session, in which the at least one game parameter corresponds to a predetermined configuration of a plurality of game elements corresponding to a predetermined game outcome." Claims 8 and 9 depend from claim 7 and are allowable for at least the same reasons as claim 7.

Claim 17 recites, *inter alia*, "receiving a wager for ~~initiating~~ a game session that includes a plurality of outcomes; initiating the game session at a gaming device operable to facilitate a wagering game; generating at least one outcome, in which each outcome includes a plurality of instances selected from a set of slot machine symbols, and the set of slot machine symbols includes a plurality of predetermined slot machine symbols; and terminating the game session based on an occurrence of an outcome that contains a predetermined plurality of instances.

Jaffe fails to disclose, teach or suggest these limitations, particularly initiating or terminating a "game session based on an occurrence of an outcome that contains a predetermined plurality of instances."

Conclusion

Applicants respectfully request favorable consideration and early passage to issue of the present application. If there are any questions regarding the present application, the Examiner is invited to contact Applicants' undersigned attorney using the information provided below.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Respectfully submitted,

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